

Oral Hearing:  
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JQ

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JUNE 27, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Twentieth Century Fox Film Corporation

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Serial Nos. 75/305,890 and 75/305,891

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Jeffrey R. Cohen and Jeffrey A. Smith of Cohen & Smith for  
applicant.

Karen McGee, Trademark Examining Attorney, Law Office 104  
(Sidney Moskowitz, Managing Attorney).

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Before Quinn, Hohein and Chapman, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Twentieth Century Fox  
Film Corporation to register the mark FOX SPORTS WORLD for  
"entertainment services in the nature of production and  
distribution of cable television programs and motion  
picture films relating to international sporting events and  
news; production of pre-recorded videotapes, video  
cassettes, video discs and CD-ROMs relating to

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international sporting events and news" and "communication services, namely, cable television broadcasting services relating to international sporting events and news."<sup>1</sup>

The Trademark Examining Attorney has refused registration in each application under Section 2(d) of the Trademark Act on the ground that applicant's mark, if used in connection with applicant's services, would so resemble the previously registered mark SPORTSWORLD for "entertainment services, namely, live and recorded sports and sports related programs exhibited through live television and other media"<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs,<sup>3</sup> and both were present at a consolidated oral hearing held before the Board. Because of the essentially identical issues involved in these appeals, the Board shall decide them in one opinion.

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<sup>1</sup> Respectively, application Serial Nos. 75/305,890 and 75/305,891, filed June 9, 1997, alleging a bona fide intention to use the mark in commerce. In each application, applicant has disclaimed the words "Sports World" apart from the mark.

<sup>2</sup> Registration No. 1,619,112, issued October 23, 1990; combined Sections 8 and 15 affidavit filed and accepted.

<sup>3</sup> Applicant accompanied its main brief with additional evidence. The Examining Attorney, in her brief, stipulated to the admission of the evidence. The stipulation was reiterated at the oral hearing. Accordingly, the evidence forms part of the record on appeal, and has been considered in reaching our decision.

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Applicant argues, in urging that the refusals to register be reversed, that its mark has a commercial impression different from the one engendered by the registered mark owned by the National Broadcasting Co., Inc. (NBC). Applicant bases its position on the alleged fame of applicant's FOX marks and its alleged family of FOX SPORTS marks. Applicant also contends that its mark falls into the case law exception to the rule that the addition of a house mark to another's registered mark does not avoid a likelihood of confusion where the registered mark (in this case, SPORTSWORLD) is descriptive, suggestive or commonly used or registered. Applicant further points to the "unique" nature of television programming and broadcasting services and to the absence of any actual confusion between the involved marks. In support of its arguments, applicant has submitted two affidavits with related exhibits, excerpts retrieved from the NEXIS database, copies of registrations and applications owned by applicant, copies of third-party registrations, and a dictionary listing for the term "world."

The Examining Attorney maintains that the marks are similar and that the services are closely related. With respect to the distinctiveness of "SPORTSWORLD" and variations thereof, the Examining Attorney submitted third-

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party registrations and applications to show that the term, in her words, "is not diluted in the field of applicant's and registrant's services."

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to a comparison of the services. Applicant contends that "the marketplace reality is that television programming and broadcasting services are quite unique" and that a "consumer changing channels is aware of the particular channel he/she is viewing due to access to numerous media guides and/or continuous visual or aural station identification." (brief, p. 9) Applicant has submitted the affidavit of Michelle Francis, senior counsel of Fox Group, who oversees applicant's intellectual property. Ms. Francis states, in pertinent part, that "[i]t is customary in the television industry to broadcast one's own sports programming on a television company's own

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network." Applicant further asserts that it is customary in the trade for a network to use its house mark in close proximity to another mark identifying the programming or broadcasting service. Applicant also contends that "[i]t is reasonable to conclude that these two entertainment and television industry leaders are well aware of each other's presence" and that it is "an unreasonable evaluation of market reality to assume that consumers are so unsophisticated...that they may mistakenly believe that NBC sponsors or licenses [applicant or its affiliates] to use FOX SPORTS WORLD." (brief, pp. 9-10)

In cases such as this, it is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the services as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the services, their channels of trade and/or classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Applicant's "communication services, namely, cable television broadcasting services relating to international sporting events and news" and "entertainment services in

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the nature of production and distribution of cable television programs and motion picture films relating to international sporting events and news; production of pre-recorded videotapes, video cassettes, video discs and CD-ROMs relating to international sporting events and news" are identical, in part, and otherwise are closely related to registrant's "entertainment services, namely, live and recorded sports and sports related programs exhibited through television and other media." Moreover, it is well settled that the services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Here, the services are rendered in the same channels of trade to the same purchasers, namely, the general public, that is, ordinary viewers of televised sports. Moreover, the services would be free or, in the

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case of cable transmission, the services would be relatively inexpensive. This low cost increases the likelihood of confusion.

Applicant's attempt to distinguish the services falls short. Rather, we find it likely, as the Examining Attorney has concluded, that "an individual who changes television channels would happen upon a sports program with the designation SPORTSWORLD or SPORTS WORLD in its name, and would not realize what channel he or she is watching, or whether applicant or registrant were the source of the program." (brief, p. 11) Indeed, given the proliferation of television channels today, a viewer who is channel surfing with a remote control may not even know the network he or she is watching. It may be that the source of the services is anonymous (that is, not every consumer will know that SPORTSWORLD identifies a show of NBC), and given the identity and/or close relationship between applicant's and registrant's services, confusion would be likely if they were rendered under similar marks.

We next turn to a consideration of the marks. We note at the outset that if the services are identical, as they are at least in part here, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp.

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v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). While applicant concedes that "at first glance the marks seem quite similar" (brief, p. 15), applicant points to a variety of factors which, in applicant's view, serve to distinguish the marks FOX SPORTS WORLD and SPORTSWORLD.

The thrust of applicant's position is that its mark has a commercial impression different from the registered mark based on the fame of applicant's FOX marks and the family of marks created under the mark FOX SPORTS; and that while the addition of a house mark to a registered mark generally is not enough to avoid likelihood of confusion, there is an exception in the case law that where the registered mark is descriptive, suggestive or commonly used or registered as here, then such addition serves to sufficiently distinguish the marks.

We find that the marks SPORTSWORLD and FOX SPORTS WORLD, when considered in their entirety, are similar in sound, appearance and meaning, conveying similar overall commercial impressions. We decline applicant's request to take judicial notice that the mark FOX is famous. Although we are willing to recognize that the mark is well known in the television industry (based on the affidavits of Ms. Francis and Tracy Dolgin), fame is a fact issue which, in

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our view, should be established by the submission of sufficient proof bearing thereon.

We also are not persuaded by applicant's family of marks argument based on applicant's use of the mark FOX SPORTS in conjunction with eleven geographic terms (e.g., "AMERICAS," "NORTHWEST" and "SOUTH").<sup>4</sup> The fact remains that in the context of this appeal, we must compare registrant's mark with the specific mark sought to be registered. In the involved applications, FOX SPORTS is not separated from WORLD. Rather, the typed mark is unitary, FOX SPORTS WORLD, and this is the mark which must be compared to registrant's mark SPORTSWORLD.

The marks are similar in that applicant has appropriated the entirety of registrant's mark (the space between SPORTS and WORLD in applicant's mark is of no consequence) and merely added its house mark FOX. As argued by the Examining Attorney, the general rule is that likelihood of confusion is not avoided between two otherwise confusingly similar marks merely by adding a

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<sup>4</sup> It would appear that applicant's claim of a family of marks is based on its ownership of several registrations and applications of marks comprising FOX SPORTS coupled with another term. The mere fact of registration of several marks with a common "surname" does not in itself prove that a family of marks exists in fact. *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419 (CCPA 1965); and *Consolidated Foods Corp. v. Sherwood Medical Industries, Inc.*, 177 USPQ 279 (TTAB 1973).

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house mark. See, e.g., *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986). As noted above, however, applicant contends that inasmuch as SPORTSWORLD is lacking in distinctiveness, the addition of FOX serves to distinguish the marks.

Applicant contends in this connection that its mark falls under an exception to the above rule because "Sports World" is in common use. We recognize that applicant's NEXIS evidence shows significant use of the term "sports world" in common, everyday language. Certainly, the term has a readily understood meaning in the vernacular, but applicant has failed to draw our attention to even one use in connection with services of the type rendered by it and registrant. The point is that, *as applied to the involved services*, the term is nothing more than suggestive. And, as applied to both applicant's and registrant's services, the term conveys the same suggestion, that is, that the programming pertains to sports events. Applicant is stretching in trying to draw distinctions between the suggestions in each mark when it argues that registrant's "SPORTSWORLD" means the community or totality of sports whereas the term in applicant's mark conveys the idea of "covering a 'world' or international scope." We believe

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that this perceived nuance would be lost on the vast majority of television viewers.

We recognize that applicant has disclaimed "Sports World" apart from its mark. Applicant submitted the voluntary disclaimer in response to the Examining Attorney's requirement of a disclaimer of only the word "Sports." Thus, the disclaimer of both terms was unnecessary. To the extent that applicant perhaps was attempting to use its voluntary disclaimer to strengthen its position in arguing no likelihood of confusion, the entry of the disclaimer does not render registrable a mark which otherwise is not registrable under Section 2(d). In re MCI Communications Corp., 21 USPQ2d 1534 (Comm. 1991).

With respect to the distinctiveness of the term "Sports World," we also note that the cited registration is on the Principal Register with no claim of acquired distinctiveness reflected on the registration. Further, although the record includes several third-party applications and registrations of SPORTSWORLD marks (and variations thereof such as SPORTS WORLD and SPORTWORLD), none of these official records lists services in the fields of entertainment and television broadcasting.

The similarities in overall commercial impressions, when the marks are considered in their entirety, simply

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outweigh the differences highlighted by applicant.

Further, in finding that the marks, when used in connection with relatively inexpensive services which are identical and/or closely related, are likely to cause confusion, we have kept in mind the normal fallibility of human memory over time and the fact that consumers retain a general rather than a specific impression of trademarks encountered in the marketplace.

Ms. Francis asserts that registrant has never notified applicant that its use of FOX SPORTS WORLD is likely to cause confusion with registrant's mark, and that applicant is not aware of any instances of actual confusion between the marks. While we have considered this factor in our likelihood of confusion analysis, it is not persuasive of a different result. In the context of this ex parte proceeding, we have no idea what registrant's views are of a likelihood of confusion with applicant's mark. In this connection, there is no consent agreement of record. Further, the test to be applied is likelihood of confusion.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed.

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Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*,  
748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register in each application  
is affirmed.

T. J. Quinn

G. D. Hohein

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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